

PATENT
Docket No.: 1018-001US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lalitha Vaidyanathan et al.

Serial No.: 09/504,159

Filed: February 15, 2000

For: ELECTRONIC DISPUTE RESOLUTION
SYSTEM

Art Unit: 3629

Examiner: Janice A.
Mooneyham

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450,
Alexandria, VA 22313

Dear Sir:

This is a Reply Brief in response to the Examiner's Answer mailed November 30, 2006. Please charge Deposit Account No. 50-1778 the amount of \$250.00 for the Reply Brief Fee. Please charge any additional fees that may be required or credit any overpayment to Deposit Account No. 50-1778.

Technology Center 3600

FEB 06 2007

RECEIVED

TABLE OF CONTENTS

	<u>Page</u>
Real Party in Interest.....	3
Related Appeals and Interferences.....	3
Status of Claims.....	3
Status of Amendments	3
Summary of the Claimed Subject Matter	4
Grounds of Rejection to be Reviewed on Appeal	4
Arguments of Appellant.....	5
Appendix: Claims on Appeal.....	15

REAL PARTY IN INTEREST

The real party in interest is SquareTrade, Inc. of San Francisco, California.

RELATED APPEALS AND INTERFERENCES

Application Serial No. 10/672,136, filed September 26, 2003, which is a continuation of the present application, is currently under appeal before the Board of Patent Appeals and Interferences.

STATUS OF CLAIMS

Claims 1-17, 20-22, 25-31, 64-73, 93-100 and 108-117 are on appeal in this case. Claims 18-19, 23, 24, 32-63, 74 have been cancelled, and claims 75-92, 101-107 have been withdrawn.

Claims 1-17, 20-22, 25-27, 64-73, 93-99, 100, 109, 110-113, and 115 stand rejected under 35 U.S.C. 103(a) as being unpatentable by Sloo (U.S. Patent No. 5,895,450) over Collins (U.S. Patent Application Publication No. US 2002/0007362 to Collins et al).

Claims 28-31, 114 and 117 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloo and Collins as applied to claims 1 and 112, and further in view of www.truste.com (retrieved from Internet Archive Wayback Machine) (hereafter "TRUSTe").

Claim 108 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Slaikeu (U. S. Patent Application Publication No. 2001/0007106) (hereafter "Slaikeu").

Claims 111 and 115 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Rejection mailed September 23, 2005 from which this Appeal has been made.

SUMMARY OF THE CLAIMED SUBJECT MATTER

In this appeal, Appellant separately argues independent claims 1-17, 20-22, 25-31, 64-73, 93-100 and 108-117. Independent claims 49, 58, 66-73 are involved in the appeal and summarized in a Supplemental Summary of the Claimed Subject Matter filed 8/25/2006. The Summary of the Claimed Subject Matter has not been restated here in accordance with MPEP 1208.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant submit the following three grounds of rejection to be reviewed on Appeal.

The first ground of rejection to be reviewed on appeal is the rejection of claims 1-17, 20-22, 25-27, 64-73, 93-99, 100, 109, 110-113, and 115 under 35 U.S.C. 103(a) as being unpatentable by Sloo over published U.S. Patent Application 2002/0007362 to Collins.

The second ground of rejection to be reviewed on appeal is the rejection of claims 28-31, 114 and 117 under 35 U.S.C. § 103(a) as being unpatentable over Sloo and Collins in view of TRUSTe.

The third ground of rejection to be reviewed on appeal is the rejection of claim 108 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Slaikeu.

The fourth ground of rejection to be reviewed on appeal is the rejection of claims 111 and 115 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

ARGUMENTS

Response to Examiner's Answer

Appellant separately argued each independent claim and many dependent claims within Appellant's Brief submitted November 2, 2005. Appellant maintains the request for separate consideration of these claims. In this Reply Brief the Appellant provides the following comments to aid the Board's understanding of the issues on appeal. Specifically, after review of the Examiner's Answer, it appears that a few central issues underlie many of the rejections of the pending claims.

1) Is an individual that at some time previously bought or sold an item over the Internet considered an "online marketplace"?

The Examiner's rejection of Appellant's claims under 35 USC 103 over Sloo in view of Collins is hinged on the premise that the Appellant's independent claims cover individuals that interact with a stand-alone complaint handling system to resolve disputes. Specifically, the Examiner summarized her position as follows:

The appellant asserts ... that the Examiner rejects applicant's claim based on the erroneous reasoning that claim 1 covers individual or entities separately and manually accessing the Sloo complaint handling system involving disputes that may have at some time been previously involved in a form of commerce on the Internet. The appellant states that the Examiner argues that because an individual may have at some point previously bought or sold goods in commerce, then the stand alone Sloo system teaches the elements of claim 1. The Examiner asserts that this is, in fact, the Examiner's position.¹

Based on this premise, the Examiner specifically interpreted many claim elements that recite or relate to the online marketplace as encompassing individuals that submits complaints to the standalone Sloo system because the complaints may "relate to" goods or services provided by a retailer or a merchant.² Appellant disagrees with this interpretation of the term "online marketplace" and "electronic marketplace" as set forth in the claims 1 and 112, respectfully.

As one example, Appellant's independent claim 1 requires electronically providing access to an online dispute resolution system to allow at least one of the

¹ Examiner's Answer, pg. 49, last paragraph - pg. 50, ln. 2. (emphasis added).

² See, e.g., Examiner's Answer at pp. 7-15.

parties to initiate a filing of the dispute from an online marketplace. Thus, the literal language of claim 1 differentiates between a party and an online marketplace. Claim 1 uses two separate terms, i.e., “parties” and “online marketplace” to distinctly refer to these different claim elements.

Further, the language of claim 1 requires electronically providing access to a dispute resolution system to allow a party to initiate filing a dispute from the online marketplace. That is, claim 1 requires that the party initiate the filing of the dispute from the online marketplace itself and not at some later time by interaction with a stand-alone dispute resolution system. This feature is described in the present application with respect to a seller interacting directly with a web page provided by the online marketplace, as a partner system, to allow a seller or buyer initiates the filing of the dispute. Specifically, FIG. 6 illustrates a complaint pre-filing process by which a seller or buyer initiates a dispute. Step 240 is shown as a web page in FIG. 6, is specifically labeled <Partner> indicating that the page is provided by the partner system. This web page of the partner system is shown as specifically including a hyperlink File Dispute. In response, the online dispute resolution system provides a complaint wizard as described on pp. 16-17 of the present application in reference to FIG. 6. At various points through the process of FIG. 6 the user is returned from the dispute resolution system to the partner system. See, e.g., pages 286 and 288 with hyperlinks back to the partner system.

Claim 1 also requires an entirely different step of receiving from at least one of the parties information related to the dispute. That is, the separate act of receiving data directly from the parties is expressly recited as a separate step within claim 1. This further provides strong evidence against construing the first step of claim 1 to cover this same act.

Consistent with the features set forth in the specification, claim 1 literally requires that the party initiate the filing of the dispute from the electronic marketplace itself. The use of two separate terms for party and marketplace, the specific language requiring that the party initiate filing a dispute *from the online marketplace*, and the explicit recitation of an additional step of receiving information from the parties related to the dispute preclude construction of claim 1 to cover the scenario envisioned by the Examiner with respect to the cited prior art.

The Examiner essentially relies on an argument that claim 1 covers the scenario where an individual involved in commerce sometime later directly accesses the stand-alone complaint handling system of Sloo or Collins to file a dispute. Under the Examiner's assertion the claims would necessarily read on a scenario where an individual shops at an online merchant's website, leaves that merchant's website, and some time later accesses the Sloo stand-alone system to file a complaint. This construction runs counter to the evidence set forth above with respect to the literal language of claim 1 and the intrinsic evidence set forth by the specification.

Moreover, Appellant submits that an individual that at some time previously bought or sold an item over the Internet cannot properly be considered an "online marketplace" even in view of well-known, ordinary understanding of the term. According to the Random House Dictionary, the marketplace means "an open area in a town where a market is held."³ According to Wikipedia, a marketplace is a space, actual or metaphorical, in which a market operates.⁴ These definitions make clear that the common understanding is that the term marketplace refers to the place or location where the goods are sold. These definitions are also consistent with Appellant's use of the term within the present application. The present application describes an "online marketplace" as "a website or an online centralized trading place."⁵ Consistent with both the intrinsic and extrinsic evidence, the literal language of claim 1 requires providing electronic access to an online dispute resolution system to allow at least one of the parties to initiate a filing of the dispute *from an online marketplace*, i.e., from the place at which the online market resides.

For at least these reasons, the Examiner's construction of claim 1 is erroneous and overlooks literal requirements of the claim. The Examiner cannot overlook plain requirements of the claim assigning a "broad, yet reasonable interpretation" of the claims. Consequently, contrary to the Examiner's assertions, an individual or entity that may have been previously involved in some form of commerce and later manually submits a complaint to the standalone Sloo or Collins complaint handling systems does not teach or suggest Appellant's claim requirement of electronically providing access to an online dispute resolution system to allow at least one of the parties to

³ Random House Unabridged Dictionary, © Random House, Inc. 2006

⁴ WWW.WIKIPEDIA.COM.

⁵ Page 11, ln. 5.

initiate a filing of the dispute from an online marketplace, as required by claim 1. In addition, contrary to the Examiner's assertion, an individual or entity that may have been previously involved in some form of commerce and later submitting a complaint to the standalone Sloo or Collins complaint handling systems fails to teach or suggest that transaction data is electronically communicated from the online marketplace to the online dispute system, as further required by claim 1.

Similarly, like claim 1, claim 112 uses the term "electronic marketplace" separately from the terms "buyers" and "sellers" and expressly requires that the "electronic marketplace" *provide a web-based community having buyers and sellers*. Thus, in view of the plain language of claim 112, the term "electronic marketplace" must be the electronic system that *provides* the web-based community, and cannot be construed to be an individual buyer or seller. For an electronic marketplace to provide a web-based community, it must be web-based, i.e., have a website that provides the community for the buyers and sellers. As with claim 1, the Examiner erred in construing claim 112 to encompass individuals that access the Sloo stand-alone system to file a complaint.

2) Did the inventors contemplate that the marketplace includes a database?

Much of the Examiner's reasoning is based on an assertion that one of ordinary skill would not reasonably conclude the inventors contemplated that the electronic marketplace includes a database. For example, with respect to claim 111, the Examiner asserted that the present application does not set forth that the online marketplace 102 of Figure 1 has a database.⁶ Similarly, with respect to claim 115, the Examiner argues that the specification fails to show support for an electronic marketplace and an online dispute resolution system having separate databases.⁷ The Examiner's Answer repeats this argument for many of the claims, as set forth in detail below.

Appellant submits that one of ordinary skill would reasonably conclude the inventors contemplated that the electronic marketplace described in the present application includes a database to store transaction data.

⁶ Examiner's Answer at pg. 35, ln. 3-4.

⁷ Id. at pg. 39, ll. 13-14.

First, this feature would clearly be inherent or implied from Figure 1 and the related description of the present application. In the present application the inventors specifically state that the online marketplace 102 of FIG.1 can be a website that provides an online centralized trading place.⁸ The inventors describe an online centralized trading place as a web-based community in which buyers and sellers are brought together in an auction format to interact and consummate transactions.⁹ The inventors even provided eBay.com as example of such an online trading place.¹⁰

Appellant submits that one of ordinary skill would easily recognize that an online trading place, such as eBay, would have a database, as recited by claims 111 and 115. The Examiner's assertion that the present application does not clearly set forth that online marketplace 102 of Figure 1 has a database fails to consider any implied or inherent features of the disclosure that references a website, such as eBay, as providing an online, centralized trading place where buyers and sellers interact and consummate transactions. The Examiner has offered no evidence or reasons as to why one of ordinary skill would conclude that the inventors failed to contemplate that, in at least one embodiment, online marketplace 102 of FIG. 1 includes a database storing data.

Second, this feature is expressly described in reference to Figure 2B of the present application. FIG. 2B of the present application shows an embodiment that expressly "allow business partners of the system to integrate with the dispute resolution system."¹¹ With respect to FIG. 2B, the inventors specifically described software objects that can reside within the partner system and send specific information to the dispute resolution system 130 of FIG. 1 including "informing the dispute resolution system 130 of relevant partner transactions."¹² The inventors then expressly described this embodiment of the online dispute resolution system as having a data manager 162 that communicates with partner databases 164.¹³

Strong contextual evidence exists throughout the present application indicating

⁸ Present application at pg. 11, ln. 5 (stating that marketplace 102 "can be a physical mall or a market or can be a website such as an online centralized trading place").

⁹ *Id.* at pg. 11, ll. 6-8.

¹⁰ *Id.* at pg. 11, ll. 15-17.

¹¹ *Id.* at pg. 14, ll. 2-3

¹² *Id.* at pg. 14, ll. 2-9.

¹³ *Id.* at pg. 14, ll. 11-12.

that that inventors clearly understood that the electronic marketplace 102 and its website described in FIG. 1 is an example of a partner system that may be integrated with the online dispute resolution system as shown in FIG. 2B. As one example, the only “system” described prior to FIG. 2B other than the dispute resolution system of FIG. 1 is marketplace 102 which is describes as a centralized trading place such as eBay.com. As another example, the inventors described the partner system as sending specific information to the dispute resolution system 130 of FIG. 1 including “informing the dispute resolution system 130 of relevant partner transactions.”¹⁴ The only use of the term “transactions” with respect to FIG. 1 prior to the description of the partner system is with respect to marketplace 102 where the inventors state that the marketplace can be a website such as an online centralized trading place for consummating transactions.¹⁵

As yet another example, in reference to a partner system, the inventors stated that the integration with online dispute resolution system “allow[s] partners to query the dispute resolution system data such as the status of a specific marketplace seller 104.”¹⁶ This is supportive of Appellant’s position in multiple ways. First the sentence refers back to a “seller 104” shown in FIG. 1 as a customer of the marketplace system 102. Secondly, the term “marketplace” is explicitly used in the sentence **interchangeably** with “partner,” i.e., that the partner system queries a “**marketplace** seller” and not simply a “**partner** seller.” This evidence strongly indicates that inventors contemplated that, in at least in certain embodiments, the electronic marketplace 102 and its website described in FIG. 1 is an example of a partner system that may be integrated with the online dispute resolution system as shown in FIG. 2B.

In view of at least the evidence identified above, one of ordinary skill in the art of electronic marketplaces would have reasonably concluded that the inventors contemplated electronic marketplace 102 of FIG. 1. as one example of a partner system. This provides express support for an online marketplace having a partner database 164. Contrary to the Examiner’s conclusions, the specification provides

¹⁴ *Id.* at pg. 14, ll. 2-9.

¹⁵ *Id.* at pg. 11, ll. 4-8.

¹⁶ *Id.* at pg. 14, ll. 8-9.

sufficient support to allow one of ordinary skill to reasonably conclude that the inventors contemplated online marketplace 102 as including a database.

3) Did the inventors contemplate the marketplace as a “system” or instead as only an individual buyer or seller?

A third argument that is central to the Examiner’s rejections is the assertion that marketplace 102 of FIG. 1 is not an online system but rather an individual buyer or seller. For example, the rejection under 112, 1st paragraph of claims 111 and 115 hinge on the premise that the present application does not clearly provide that online marketplace 102 of FIG. 1 is not an online marketplace. Specifically, in response to Appellant’s arguments with respect to claims 111 and 115, the Examiner stated:

However, the Examiner does not agree that this present application makes clear that the online marketplace is a system that provides a centralized trading place, and is not an individual buyer or seller.¹⁷

Appellant submits that one of ordinary skill would reasonably conclude that the inventors contemplated at least one embodiment in which the marketplace is a system that provides a centralized trading place, and not an individual buyer or seller. The present application: (1) states that online marketplace 102 of FIG.1 can be a website such as an online centralized trading place for consummating transactions between buyers and sellers,¹⁸ and (2) provides eBay as an example online trading place.¹⁹ One of ordinary skill would readily understand that, in referring to marketplace 102 as an online trading place such as eBay.com, the inventors contemplated that the marketplace would be a “system” and not an individual buyer or seller.

Second, the Examiner’s assertion that the inventors contemplated marketplace 102 solely as individuals and not an online system is contextually at odds with much of the language of the present application and the figures. For example, Figure 1 of the present application illustrates sellers 104, consumers 106 and marketplace 102 as separate entities. The present application states that, as a centralized trading place, marketplace 102 facilitates buyers and sellers meeting, listing items for sale,

¹⁷ Examiner’s Answer, pg. 29, ll. 7-10 (emphasis added).

¹⁸ Present Application at pg. 11, ll. 5-8.

¹⁹ *Id.* at pg. 11, ll. 11-17.

exchanging information, interacting with each other and, ultimately, consummating transactions.²⁰

Moreover, at pg. 13, ll. 13-14, the present application describes a “customer” of the dispute resolution system as either a buyer or seller interacting with a workstation 152. FIG. 2B clearly shows workstation 152 as completely separate from partner database 162 of the partner system. This makes clear that the inventors contemplated that the business partner is a system separate from an individual “buyer” or “seller.” This differentiation between “customer” being both “buyer and seller” and being very different from the “partner” such as a “marketplace” is further supported by paragraph [0048] where “**Partners** integrate with the system, by exposing relevant functionality on their respective websites, for example allowing **customers** to dispute a transaction”, where “Partner is the marketplace hosting the transaction and the buyer and seller are the two “**customers**” involved in the specific transaction. Further evidence illustrating that the inventors contemplated the “partner” as being separate from an individual “seller” is provided in paragraph [0051] that states:

[I]f **the seller** enters its identification and password information, and if **the seller** is registered with the system of Fig. 1 but is not covered for transactions with the **desired partner**, the process of Fig. 4 secures coverage and displays a page 250 to notify **the seller that transactions with the desired partner are now covered by the dispute resolution system.**

As additional evidence, original claim 41 filed on February 15, 2000 is a system claim that clearly and separately recites to a dispute resolution system, an electronic marketplace, and buyers and sellers transacting within the marketplace.

Thus, the present application: (1) refers to and depicts marketplace 102 separately from the buyers and sellers, (2) describes the marketplace as an online website where multiple buyers and sellers can interact to list items and consummate transactions, (3) provides eBay.com as a specific example, and (4) expressly refers to partner “systems” as integrating with the online dispute resolution system.

Contrary to the Examiner’s conclusion, the overwhelming evidence strongly suggests that the inventors contemplated the marketplace as an example “partner system” and not just an individual.

²⁰ Present Application at pg. 11, ll. 5-8.

The First Ground of Rejection to be Reviewed
on Appeal (Claims 1-17, 20-22, 25-27, 64-73, 93-99, 100, 109, 110-113, and 115)

In the Office Action, the Examiner rejected Appellant's claims 1-17, 20-22, 25-27, 64-73, 93-99, 100, 109, 110-113, and 115 under 35 U.S.C. 103(a) as being unpatentable over Sloo in view of Collins. The Examiner's rejection of independent claims 1 and 112 is based solely on the argument that an individual is a marketplace. Based on this reasoning, the Examiner asserts that Applicant's claims encompass an individual or entity that may have been previously involved in some form of electronic commerce and later manually submits a complaint to the standalone Sloo or Collins complaint handling systems. This issue has been addressed in detail above and in Appellant's Brief previously submitted.

For these reasons set forth above and detailed in Appellant's Brief, even in combination, Sloo in view of Collins fails to teach or suggest providing access to an online dispute resolution system to allow at least one of the parties to initiate a filing of the dispute *from an online marketplace*, as required by claim 1. Sloo in view of Collins also fails to teach or suggest electronically receiving with the online dispute resolution system transaction data *from the marketplace*, wherein the transaction data describes transactions within the marketplace, as required by claim 1.

Similarly, for the reasons set forth above and detailed in Appellant's Brief, Sloo in view of Collins fails to teach or suggest an online dispute resolution system that *electronically receives transaction data from a marketplace that provides a web-based community having buyers and sellers of goods and services*, the transaction data describing transactions within the electronic marketplace, as required by claim 112. Moreover, Sloo in view of Collins fails to teach or suggest that the online dispute resolution system *electronically provides status data to the marketplace* based on participation of the buyers or sellers within the online dispute resolution process, as further required by claim 112.

The Second Ground of Rejection to be Reviewed
on Appeal (Claims 28-31, 114 and 117)

In the Office Action, the Examiner rejected claims 28-31, 114 and 117 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of TRUSTe. For purposes of this appeal, Appellant limits review to dependent claim 30.

Dependent claim 30

Appellant's claim 30 requires communicating membership data from the online dispute resolution system to the online marketplace, and automatically showing a visual indicia within the marketplace to indicate the availability of the dispute resolution system and the membership of buyers or sellers in the dispute resolution process. Appellant has addressed the construction of the term "online marketplace" above and submits that the rejection of claim 30 should be reversed based on this same error. The Examiner's reasoning entirely overlooks the requirement of communicating membership data from the online dispute resolution system to an online marketplace.

For at least the reasons set forth above, Appellant respectfully requests reversal of the rejections of claim 30 under 35 U.S.C. § 103.

The Third Ground of Rejection to be Reviewed
on Appeal (Claim 108)

The Examiner rejected claim 108 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Slaikeu. In the Examiner's Answer, the Examiner relied on official notice of facts outside of the record. As Appellant's have pointed out in Appellant's previous Brief, this is only permitted when the facts are capable of "instant and unquestionable demonstrations as being well-known."²¹ Moreover, when a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is

²¹ See MPEP 2144.02, quoting *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 420 (CCPA 1970).

subject to contradiction or explanation by the affidavits of the Appellant and other persons.²²

The Examiner has not submitted any affidavit, analysis or reasoning to address this claim. Instead, she asserts that it is the Appellant's burden to thoroughly point out the errors in the Examiner's reliance on Official Notice. This premise contradicts established precedent.²³ Appellant is not required to point to any particular error in an Examiner's action when the Examiner does not even set out the facts themselves or cite any supporting evidence. This burden falls squarely on the Examiner.²⁴

For at least the reasons set forth above, Appellant respectfully request reversal of the rejections of claim 108 under 35 U.S.C. § 103.

**The Fourth Ground of Rejection to be Reviewed
on Appeal (Claims 111 and 115)**

Claims 111 and 115 stand rejected for failing to comply with the written description requirement under 35 U.S.C. 112, first paragraph. After review of the Examiner's Answer, it is clear that the Examiner rejected claims 111 and 115 based solely on the arguments that (1) the inventors did not contemplate that the marketplace includes a database, and (2) the inventors did not contemplate the marketplace as a "system." These issues have been addressed in detail above. For at least the reasons set forth above, Appellant submits that claims 111 and 115 satisfy the written description requirement under 35 U.S.C. 112, first paragraph.

²² See 37 CFR 1.104(d)(2).

²³ See MPEP 2144.02, quoting *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 420 (CCPA 1970).

²⁴ See MPEP 2144.02, quoting *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 420 (CCPA 1970).

Conclusion of Arguments

In view of Appellant's arguments, claims 1-17, 20-22, 25-31, 64-73, 93-100 and 108-117 are in condition for allowance. Rejection is improper and should be reversed.

Respectfully submitted,

Date:

By:

January 30, 2007
Shumaker & Sieffert, P.A.
8425 Seasons Parkway, Suite 105
St. Paul, Minnesota 55125
Telephone: (651) 735-1100 ext. 11
Facsimile: (651) 735-1102

Kent J. Sieffert
Name: Kent J. Sieffert
Reg. No.: 41,312

APPENDIX: CLAIMS ON APPEAL

Claim 1 (Previously Presented): A method for resolving an electronic commerce dispute involving one or more parties, comprising:

electronically providing access to an online dispute resolution system to allow at least one of the parties to initiate a filing of the dispute from an online marketplace;

electronically receiving with the online dispute resolution system transaction data from the marketplace, wherein the transaction data describes transactions within the marketplace;

receiving from at least one of the parties information related to the dispute;
and

executing software with the online dispute resolution system to apply an online dispute resolution process that utilizes at least a portion of the transaction data from the marketplace and the information to assist the parties in resolving the dispute.

Claim 2 (Previously Presented): The method of claim 1, further comprising automatically selecting one of two modes of resolving the dispute, the first mode requiring the online dispute resolution process being driven by an electronic agent to assist the parties in resolving the dispute and the second mode involving a human dispute resolution specialist.

Claim 3 (Previously Presented): The method of claim 109, wherein the case-based reasoning system contains a history file.

Claim 4 (Previously Presented): The method of claim 3, wherein the history file contains patterns and precedents, further comprising applying the patterns and precedents to generate an outcome prediction.

Claim 5 (Previously Presented): The method of claim 4, further comprising presenting the outcome prediction to the parties to assist the parties in selecting the mode of resolving the dispute.

Claim 6 (Previously Presented): The method of claim 4, wherein the outcome prediction includes one or more likely outcomes and associated probabilities of occurrence.

Claim 7 (Previously Presented): The method of claim 1, further comprising receiving settlement position from the parties.

Claim 8 (Original): The method of claim 7, further comprising automatically settling the dispute if the settlement positions satisfy a predetermined criteria.

Claim 9 (Original): The method of claim 8, wherein the predetermined criteria relates to a monetary settlement position.

Claim 10 (Original): The method of claim 8, wherein the predetermined criteria relates to a non-monetary settlement position.

Claim 11 (Previously Presented): The method of claim 2, wherein the dispute resolution specialist resolves the dispute by transitioning from a mediation stage to an arbitration stage.

Claim 12 (Previously Presented): The method of claim 2, wherein the dispute resolution specialist generates a final recommended resolution.

Claim 13 (Original): The method of claim 12, wherein the final recommended resolution is accepted by the one or more parties.

Claim 14 (Previously Presented): The method of claim 12, further comprising creating a contract between the one or more parties stating the willingness to abide by the recommended resolution.

Claim 15 (Previously Presented): The method of claim 2, further comprising communicating among the parties using a plurality of communication modes.

Claim 16 (Previously Presented): The method of claim 15, wherein the communication modes include a public messaging mode in which communication is automatically shared between all of the parties and the dispute resolution specialist, and a private messaging mode in which communication for a given one of the parties is automatically shared only between that one of the parties and the dispute resolution specialist.

Claim 17 (Original): The method of claim 15, wherein the communication mode is selected by the dispute resolution specialist.

Claims 18-19 (Cancelled).

Claim 20 (Previously Presented): The method of claim 1, further comprising providing visual cues when applying the dispute resolution process to automatically highlight agreements between the parties.

Claim 21 (Original): The method of claim 20, further comprising visually highlighting areas of agreement and disagreement.

Claim 22 (Previously Presented): The method of claim 1, further comprising storing status data on participation of the parties in the dispute resolution process.

Claims 23-24 (Cancelled).

Claim 25 (Previously Presented): The method of claim 22, wherein the data relates to compliance of a participant to a result of the resolution of the dispute.

Claim 26 (Previously Presented): The method of claim 22, further comprising:
communicating the status data from the dispute resolution system to the marketplace; and
highlighting an offender based on the status information.

Claim 27 (Previously Presented): The method of claim 2, further comprising providing a market-based system for assigning the dispute resolution specialist to a particular dispute.

Claim 28 (Previously Presented): The method of claim 1, wherein the dispute resolution is provided as an insurance covering the transactions.

Claim 29 (Previously Presented): The method of claim 28, further comprising requiring a seller associated with the marketplace to be a registered subscriber to the online dispute resolution system before the transactions are insured.

Claim 30 (Previously Presented): The method of claim 1, further comprising:
communicating membership data from the online dispute resolution system to the marketplace; and
automatically showing a visual indicia within the marketplace to indicate the availability of the dispute resolution system and the membership of buyers or sellers in the dispute resolution process.

Claim 31 (Previously Presented): The method of claim 30, wherein the visual indicia is a medallion that is a visible symbol of trust to increase the confidence of the buyers or the sellers in executing transactions within the marketplace.

Claims 32-63 (Cancelled).

Claim 64 (Previously Presented): The system of claim 112, wherein the online dispute resolution system further comprises:

a database to store facts and outcomes of previously resolved disputes; and
a server that receives case information related to the dispute and compares the case information to the facts of previously resolved disputes stored by the database to produce a result for use in selection of a mode of resolving the dispute, and presents a result of the comparison to the parties via the network.

Claim 65 (Previously Presented): The system of claim 64, wherein the server searches the database to identify previously resolved disputes with facts that are similar to the case information.

Claim 66 (Previously Presented): The system of claim 65, wherein the server presents the result of the comparison by presenting the outcomes of identified previously resolved disputes.

Claim 67 (Previously Presented): The system of claim 66, wherein the server summarizes the outcome of identified previously resolved disputes.

Claim 68 (Previously Presented): The system of claim 65, wherein the server presents the result of the comparison by generating an outcome prediction as a function of the facts and outcomes of the identified disputes, and presenting the outcome prediction to the parties.

Claim 69 (Previously Presented): The system of claim 68, wherein the outcome prediction includes at least one likely outcome.

Claim 70 (Previously Presented): The system of claim 69, wherein the outcome prediction includes associated probabilities of occurrence of the at least one likely outcome.

Claim 71 (Previously Presented): The system of claim 69, wherein the server presents the at least one likely outcome to the parties as a potential resolution of the dispute.

Claim 72 (Previously Presented): The method of claim 15, further comprising:
determining a current mode of resolving the dispute; and
automatically selecting a communication mode based on the determination.

Claim 73 (Previously Presented): The method of claim 22, further comprising providing the data to the parties to assist the resolution of the dispute.

Claim 74 (Cancelled)

Claim 75 (Withdrawn): A system comprising:

- a computer network; and
- a server coupled to the computer network that receives case information that describes an electronic commerce dispute from one or more parties to the dispute via the network, and compares the case information to facts of previously resolved disputes to automatically select a resolution mode comprising one of (i) a direct negotiation mode that allows the parties to directly negotiate a resolution to the dispute via the computer network, (ii) a conciliation mode that allows the parties to negotiate the resolution to the dispute through a mediator, and (iii) mediation mode that allows a mediator to propose a resolution to the dispute.

Claim 76 (Withdrawn): The system of claim 75, wherein the server provides a pre-programmed recommended resolution to at least one of the parties based on the comparison.

Claim 77 (Withdrawn): A method for encouraging parties to an electronic commerce dispute to resolve the dispute through direct negotiation via a computer network comprising:

- maintaining a database that stores facts and outcomes of previously resolved electronic commerce disputes;
- receiving case information that describes the electronic commerce dispute from one or more of the parties to the dispute via the network;
- searching the database to identify previously resolved disputes with facts that are similar to the case information;
- identifying at least one likely outcome of the dispute based on the outcomes of the identified previously resolved disputes; and
- presenting the identified likely outcomes to the parties as a potential resolution to the dispute to assist the parties in negotiating a resolution to the dispute.

Claim 78 (Withdrawn): A method for integrating an online dispute resolution system with an electronic marketplace to allow users of the electronic marketplace to resolve disputes and provide users of the electronic assurance that disputes will be resolved comprising:

- providing an electronic marketplace as a website that is accessed by users via a computer network and enables the users to buy and sell items;

- indicating within the electronic marketplace website the availability of a dispute resolution system that is coupled to the computer network to resolve disputes between the users of the electronic marketplace;

- embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website to enable users of the electronic marketplace to access the dispute resolution system from the electronic marketplace; and

- displaying media objects within the website that are associated with users of the electronic marketplace,

- wherein the appearance of the media objects is related to data maintained by the online dispute resolution system that is related to use of the dispute resolution system by the users.

Claim 79 (Withdrawn): A method comprising:

- providing an electronic marketplace that is accessed by users via a computer network and enables the users to buy and sell items; and

- indicating the availability of a dispute resolution system to resolve disputes between the users of the electronic marketplace by displaying to the users one or more medallion associated with the dispute resolution system within the electronic marketplace.

Claim 80 (Withdrawn): The method of claim 79, further comprising displaying the media objects to indicate which of the users are members in the dispute resolution system.

Claim 81 (Withdrawn): The method of claim 80, further comprising controlling the appearance of the media objects based on data maintained by the dispute resolution system that describes the use of the dispute resolution system by the users.

Claim 82 (Withdrawn): The method of claim 81, further comprising controlling the appearance of the media objects based on participation of the users within the dispute resolution processes and compliance with results of the dispute resolution process.

Claim 83 (Withdrawn): A method for indicating to users of an electronic marketplace whether other users of the electronic marketplace participate in an online dispute resolution system comprising:

- providing an electronic marketplace via a website that is accessed by users via a computer network and enables the users to buy and sell items;

- displaying media objects received from the dispute resolution system and associated with users of the electronic marketplace that participate in the dispute resolution system within the website,

- wherein the appearance of the media objects is related to data maintained by a server associated with the dispute resolution system relating to participation of the users of the electronic marketplace in the dispute resolution system.

Claim 84 (Withdrawn): The method of claim 83, wherein displaying media objects comprises displaying medallions within web pages associated with users of the electronic marketplace that participate in the dispute resolution system.

Claim 85 (Withdrawn): An online dispute resolution system comprising a computing system that performs a computer-assisted multi-mode dispute resolution process for resolving a dispute between two parties, wherein the computing system:

- performs an analysis of the dispute and present pre-programmed recommended resolutions based on the analysis in a first mode;

- performs a match of needs of the two parties as defined by the dispute to resolve the dispute in a second mode;

- provides a medium for the parties to independently resolve the dispute in a third mode; and

- assigning a dispute resolution specialist to resolve the dispute in a fourth mode upon failure to reach a resolution in at least one of the other modes.

Claim 86 (Withdrawn): The method of claim 85, wherein the dispute resolution specialist utilizes a message exchange of the computing system to interact with the parties to reach a recommended resolution.

Claim 87 (Withdrawn): The method of claim 85, wherein the computing system assigns the dispute resolution specialists

Claim 88 (Withdrawn): An online dispute resolution system comprising:

- a software program to automatically assemble case information that describes an electronic commerce dispute between parties from records provided by the parties,

- wherein the software module presents sample resolutions to the parties to aid the parties in resolving the case, and disaggregates elements of the dispute and presents the case information in a form that identifies areas of agreement between the parties.

Claim 89 (Withdrawn): The system of claim 88, further comprising a case base reasoning system that processes the case information that identifies similar past cases, and presents one or more settlement proposals and likely outcomes for the parties to assist the parties in resolving the dispute.

Claim 90 (Withdrawn): The online dispute resolution system of claim 88, further comprising a software program to prompt settlement between the parties.

Claim 91 (Withdrawn): A method comprising:

- training a dispute resolution specialist by requiring the dispute resolution specialist to experience transactions within online marketplaces including at least an auction site;

- presenting simulated online dispute resolution cases to the dispute resolution specialists to assess the skills of the dispute resolution specialists; and

- assigning online disputes to the dispute resolution specialists only upon completion of the training and successful resolution of the simulated online dispute resolution cases.

Claim 92 (Withdrawn): An online dispute resolution system comprising:

- a first software program operating on a computing system to assemble case information that describes an electronic commerce dispute between parties from records provided by the parties; and

- a second software program operating on the computing system to assist a dispute resolution specialist in identifying similar cases from a historical database of past cases.

Claim 93 (Previously Presented): The system of claim 64, wherein the server compares the case information to facts of previously resolved disputes to automatically select a resolution mode comprising one of (i) a direct negotiation mode that allows the parties to directly negotiate a resolution to the dispute via the computer network, (ii) a conciliation mode that allows the parties to negotiate the resolution to

the dispute through a mediator, and (iii) mediation mode that allows a mediator to propose a resolution to the dispute.

Claim 94 (Previously Presented): The system of claim 93, wherein the server provides a pre-programmed recommended resolution to at least one of the parties based on the comparison.

Claim 95 (Previously Presented): The system of claim 64, wherein the server:

- performs an analysis of the dispute and present pre-programmed recommended resolutions based on the analysis in a first mode;
- performs a match of needs of the two parties as defined by the dispute to resolve the dispute in a second mode;
- provides a medium for the parties to independently resolve the dispute in a third mode; and
- assigns a dispute resolution specialist to resolve the dispute in a fourth mode upon failure to reach a resolution in at least one of the other modes.

Claim 96 (Previously Presented): The system of claim 95, wherein the server provides a message exchange by which the dispute resolution specialist interacts with the parties to reach a recommended resolution.

Claim 97 (Previously Presented): The system of claim 95, wherein the server automatically assigns the dispute resolution specialists.

Claim 98 (Previously Presented): The system of claim 64, further comprising a software program executing on the server to automatically assemble the case information from records provided by the parties, wherein the software module presents sample resolutions to the parties to aid the parties in resolving the case, and presents the case information in a form that identifies areas of agreement between the parties.

Claim 99 (Previously Presented): The system of claim 64, further comprising:

- a first software program operating the server to assemble the case information from records provided by the parties; and

- a second software program operating on the server to assist a dispute resolution specialist in identifying similar cases from a historical database of past cases.

Claim 100 (Previously Presented): The method of claim 1, further comprising maintaining a database that stores facts and outcomes of previously resolved electronic commerce disputes, and wherein executing software apply a case-based reasoning system comprises:

- searching the database to identify previously resolved disputes with facts that are similar to the case information;

- identifying at least one likely outcome of the dispute based on the outcomes of the identified previously resolved disputes; and

- presenting the identified likely outcomes to the parties as a potential resolution to the dispute to assist the parties in negotiating a resolution to the dispute.

Claim 101 (Withdrawn): The method of claim 1, further comprising:

providing an electronic marketplace as a website that is accessed by users via a computer network and enables the users to buy and sell items;

indicating within the electronic marketplace website the availability of a dispute resolution system that is coupled to the computer network to resolve disputes between the users of the electronic marketplace;

embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website to enable users of the electronic marketplace to access the dispute resolution system from the electronic marketplace; and

displaying media objects within the website that are associated with users of the electronic marketplace,

wherein the appearance of the media objects is related to data maintained by the online dispute resolution system that is related to use of the dispute resolution system by the users.

Claim 102 (Withdrawn): The method of claim 1, further comprising:

providing an electronic marketplace that is accessed by users via a computer network and enables the users to buy and sell items; and

indicating the availability of a dispute resolution system to resolve disputes between the users of the electronic marketplace by displaying to the users one or more medallion associated with the dispute resolution system within the electronic marketplace.

Claim 103 (Withdrawn): The method of claim 102, further comprising displaying the media objects to indicate which of the users are members in the dispute resolution system.

Claim 104 (Withdrawn): The method of claim 102, further comprising controlling the appearance of the media objects based on data maintained by the dispute resolution system that describes the use of the dispute resolution system by the users.

Claim 105 (Withdrawn): The method of claim 102, further comprising controlling the appearance of the media objects based on participation of the users within the dispute resolution processes and compliance with results of the dispute resolution process.

Claim 106 (Withdrawn): The method of claim 1, further comprising:

- providing an electronic marketplace via a website that is accessed by users via a computer network and enables the users to buy and sell items;

- displaying media objects received from the dispute resolution system and associated with users of the electronic marketplace that participate in the dispute resolution system within the website,

- wherein the appearance of the media objects is related to data maintained by a server associated with the dispute resolution system relating to participation of the users of the electronic marketplace in the dispute resolution system.

Claim 107 (Withdrawn): The method of claim 101, wherein displaying media objects comprises displaying medallions within web pages associated with users of the electronic marketplace that participate in the dispute resolution system.

Claim 108 (Previously Presented): The method of claim 1, further comprising:

- training a dispute resolution specialist by requiring the dispute resolution specialist to experience transactions within online marketplaces including at least an auction site;

- outputting simulated online dispute resolution cases to the dispute resolution specialists via the computer network to assess the skills of the dispute resolution specialists; and

- assigning online disputes to the dispute resolution specialists only upon completion of the training and successful resolution of the simulated online dispute resolution cases.

Claim 109 (Previously Presented): The method of claim 1, further comprising applying a case-based reasoning system to the information to produce a result for use in selection of a mode of resolving the dispute in accordance with an online dispute resolution process.

Claim 110 (Previously Presented): The method of claim 1, further comprising:
electronically receiving with the online dispute resolution system enrollment requests from the marketplace; and
automatically initiating enrollment of sellers or buyers within the dispute resolution system in response to the electronic requests from the marketplace.

Claim 111 (Previously Presented): The method of claim 1, wherein the online dispute resolution system and the marketplace have separate databases, the method further comprising:
automatically electronically communicating the transaction data between the database of the online dispute resolution system and the database of the electronic marketplace.

Claim 112 (Previously Presented): A system comprising:
an online dispute resolution system that electronically receives transaction data from a marketplace that provides a web-based community having buyers and sellers of goods and services, the transaction data describing transactions within the electronic marketplace,
wherein the dispute resolution system executes software that utilizes the transaction data and applies a dispute resolution process to assist the buyers or sellers in resolving disputes relating to the transactions, and
wherein the online dispute resolution system electronically provides status data to the marketplace based on participation of the buyers or sellers within the online dispute resolution process.

Claim 113 (Previously Presented): The system of claim 112, wherein the online dispute resolution system electronically receives enrollment requests from the marketplace, and initiates enrollment of sellers or buyers within the dispute resolution system in response to the enrollment requests.

Claim 114 (Previously Presented): The system of claim 112, wherein the online dispute resolution system comprises a membership database that maintains the status data for the sellers and buyers of the marketplace that are members of the online dispute resolution system.

Claim 115 (Previously Presented): The system of claim 112,
wherein the online dispute resolution system and the marketplace have separate databases, and
wherein the online dispute resolution system comprises a data manager software application to automatically communicate data between the database of the online dispute resolution system and the database of the electronic marketplace.

Claim 116 (Previously Presented): The system of claim 114, wherein the dispute resolution system and the marketplace are implemented at least in part as software executing on a computer system having data storage devices.

Claims 117 (Previously Presented): The system of claim 116, wherein the dispute resolution system and the marketplace communicate via the computer system.

APPENDIX: EVIDENCE

None

APPENDIX: RELATED PROCEEDINGS

None

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lalitha Vaidyanathan;
John Quinn; Ahmedulla
Khaishgi; Cara Cherry-
Lisco

Serial No.: 09/504,159

Filed: February 15, 2000

Examiner: Janice A. Mooneyham

Group Art Unit: 3629

Docket No.: 1018-001US01

Title: ELECTRONIC DISPUTE RESOLUTION SYSTEM

Confirmation No.

7527

Customer No.:

28863

RECEIVED
2007 FEB -5 PM 2:57
U.S. PATENT & TRADEMARK OFFICE

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being deposited with the United States Post Service, as First Class Mail, in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on February 1, 2007.

By: 
Name: Karen Sorensen

Technology Center 3600

RECEIVED
FEB 06 2007

RECEIVED

RESUBMISSION OF REPLY BRIEF

MAIL STOP APPEAL BRIEF -PATENTS

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

On January 30, 2007, Appellant submitted a Reply Brief in a timely manner within two months from the Examiner's Answer mailed November 30, 2007. Attached hereto is the Reply Brief as originally submitted including the original transmittal having a Certificate under 37 C.F.R. 1.8, signed by Kent J. Sieffert, stating that the Reply Brief was deposited with the U.S. Postal Service as first class mail on January 30, 2007. After mailing, the Reply Brief was returned to the Appellant by the U.S. Postal Service. Applicant respectfully requests acceptance of Appellant's Reply Brief as timely submitted for consideration by the Board.

Please apply any charges not covered, or any credits, to Deposit Account No. 50-1778.

Date:

2/1/2007

By:

Kent J. Sieffert

SHUMAKER & SIEFFERT, P.A.

8425 Seasons Parkway, Suite 105

St. Paul, Minnesota 55125

Telephone: 651.735.1100

Facsimile: 651.735.1102

Name: Kent J. Sieffert

Reg. No.: 41,312

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lalitha Vaidyanathan; Confirmation No. 7527
John Quinn; Ahmedulla
Khaishgi; Cara Cherry-
Lisco
Serial No.: 09/504,159
Filed: February 15, 2000 Customer No.: 28863
Examiner: Janice A. Mooneyham
Group Art Unit: 3629 Docket No.: 1018-001US01
Title: ELECTRONIC DISPUTE RESOLUTION SYSTEM

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being deposited with the United States Post Service, as First Class Mail, in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on January 30, 2007.

By: 

Name: Kent Sieffert

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
Alexandria, VA 22313-1450

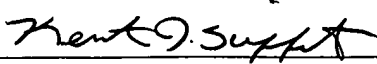
Sir:

We are transmitting herewith the attached correspondence relating to this application:

- ☒ Transmittal sheet containing Certificate of Mailing
- ☒ Reply Brief (34 pgs.) in triplicate
- ☒ Request for Oral Hearing (1 pg.)
- ☒ Return postcard

Please charge Deposit Account No. 50-1778 for fees for the Reply Brief (\$250.00) and the Request for Oral Hearing (\$500.00). Any additional fees that may be required or credits of overpayment can be made to Deposit Account No. 50-1778.

Date:
January 30, 2007

By: 
Name: Kent J. Sieffert
Reg. No.: 41,312

SHUMAKER & SIEFFERT, P.A.
8425 Seasons Parkway, Suite 105
St. Paul, Minnesota 55125
Telephone: 651.735.1100
Facsimile: 651.735.1102

Technology Center 3600

FEB 06 2007

RECEIVED